REMARKS

Entry of the foregoing, and reconsideration and further examination of the subject application, in light of the amendments above and the remarks below, are respectfully requested.

Status of Claims

By the above amendments, claims 1, 4-6, 14-15, and 30-31 have been amended to address certain informalities. No additional claims have been added or deleted.

Upon entry of the foregoing amendments, claims 1, 3-33, and 68-72 will remain pending in the application. Each of these claims is under consideration.

Claim Ojections

In the Office Action, claims 6 and 15 were objected to for being in improper dependent form. Claims 6 and 15 have been amended to address the Examiner's concern.

Claim Rejections – 35 U.S.C. § 112

Claims 1, 4, 5, and 14 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. These claims have also been amended to address the informalities raised by the Examiner.

Claim Rejections – 35 U.S.C. § 102

Claims 1 and 68 were rejected under 35 U.S.C. § 102(b) as being anticipated by Pfaendner (US 5,859,073) or Hudson (US 6,077,890). For the following reasons, this rejection should be withdrawn.

Pfaendner

Pfaendner does not disclose or suggest each feature of the rejected claims. For example, Pfaendner does not disclose or suggest a polyester/polycarbonate blend where the polyester has been prepared in the presence of a metallic catalyst.

Moreover, Pfaendner does not specifically disclose a polyester/polycarbonate blend comprising both a HALS and a phosphorus-containing compound. While HALS's are mentioned, it is cited among a long list of possible additives. The list spans five columns of the patent. See col. 20, line 14 - col. 25, line 23. Also, the component containing the phosphite (component b_1)) in Pfaendner is optional. See col. 1, lines 39-45. There is no specific disclosure or suggestion of a PES/PC blend that includes both component b_1) and a HALS. Therefore, Pfaendner does not anticipate claims 1 or 68.

We note the Examiner's comment in the Office Action that "[a] reference that clearly names the claimed species anticipates the claim no matter how many other species are named." While the comment may be accurate, it doesn't apply here. That proposition applies to situations where the claim is directed to the particular species disclosed. Here, however, the instant claims are not to directed a species that is disclosed by the reference. Rather, the claims are directed to a combination, and Pfaendner does not specifically disclose the combination.

Even the Board decision cited in the Office Action, *Ex parte A*, recognizes that the current situation presents a significantly different set of facts from the proposition cited by the Examiner. In distinguishing over cases cited by the Appellant in that case, the Board said "[i]n each case, [as it is here,] to arrive at the claimed subject matter, it was necessary to select portions of that subject matter from various sections of the reference disclosure and combine them, e.g., selecting values for variable substituents to interpolate into a generic structural formula to arrive at a specific compound." 17 USQP2d 1716, 1718 (Bd. Pat. Appeals and Interf.) (internal footnote omitted).

Here, to even come close to the claimed subject matter, it is necessary to select portions of Pfaendner, e.g., the presence of component b_1), the presence of an additive, the additive being a HALS. Thus, the proposition cited by the Examiner does not apply here.

Hudson

Hudson does not disclose or suggest each feature of the rejected claims. For example, Hudson does not specifically disclose or suggest a blend of a polycarbonate

with a polyester. While both are mentioned, the two are not specifically disclosed as a combination.

Moreover, Hudson does not disclose or suggest using a polyester that has been prepared in the presence of a metallic catalyst.

Further, Hudson fails to disclose or suggest using a phosphorus-containing compound as defined in claim 1. In this regard, we note the Examiner's comment in the Office Action that "[t]he Irgafos 12 phosphite taught by Hudson et al. reads on applicants' claims because in phosphorus-containing compound (6) R_5 and R_6 can be aryl." While it is true that R_5 and R_6 can be aryl in compound (6) of the present claims, Irgafos 12 does not "read" on Applicants' compound (6). The aryl rings in Irgafos 12 are substituted at the 2 and 4 positions. In contrast, compound (6) is unsubstituted in those positions, but are substituted at positions 3 and 5. Thus, Irgafos 12 does not satisfy compound (6) of the rejected claims.

Accordingly, Hudson does not anticipate claims 1 or 68.

Claim Rejection – 35 U.S.C. § 103

Claims 1, 3-33, and 68-71 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Pfaendner or Hudson in view of Jackson (US 4,287,325), Morris (US 4,525,504), Light (US 4,578,437), Funasaki (US 4,956,407), Carico (US 4,972,015), Golder (US 5,032,631), Dickerson (US 5,656,715), Minnick (US 5,919,848), Webster (US 5,965,261), Cornell (US 6,054,551), Cobb (US 6,100,320), Jones (US 6,103,857), Aylward (US 6,187,523), Keep (US 6,277,905 B1), Panandiker (US 6,284,845), Opalko (US 6,469,083), Moskala (US 6,551,688), Jeon (US 6,342,579), Agnici (US 2002/0045022), or Pierre (US 2003/0045022).

We cannot respond to this rejection, because there is no explanation in the Office Action of how the cited documents are proposed to be applied against the rejected claims. A review of the obviousness rejection cited in the prior Office Action does not assist us in this effort, since that rejection is different from the current one.

Suffice it to say, however, that none of the cited documents discloses or suggests the unexpected benefits that can be obtained by using the claimed combination of a phosphorus-containing compound and a HALS with a blend of a

polycarbonate and a polyester prepared with a metal catalyst. In particular, none of the applied references discloses or suggests that the claimed combination can provide both good color and improved hydrolytic stability.

As seen from Examples 1-6 of the present description, good color and improved hydrolytic stability of polycarbonate-polyester blends can be realized by a combination of a phosphite stabilizer and a HALS. In particular, Examples 1, 2, and 6 show that blends containing the phosphite stabilizer (Example 2) exhibit significantly improved color (i.e., less yellowness) compared to blends without stabilizer (Example 1) or blends with the HALS (Example 6). Unfortunately, the use of the phosphite stabilizer has a detrimental effect on the hydrolytic stability of the blend, especially the polycarbonate component (Example 2). Examples 3-5 show that blends containing both the phosphite stabilizer and the HALS exhibit significantly improved hydrolytic stability compared to the blend containing only the phosphite stabilizer (Example 2), while maintaining color levels much lower than blends without stabilizer (Example 1) or blends with the HALS (Example 6). Thus, the subject matter of the present claims provides unexpected results over what was known in the art.

Accordingly, there is no *prima facie* case of obviousness, and the rejection under 35 U.S.C. § 103(a) should be withdrawn.

Conclusion

Applicants believe that the application is in condition for allowance. Accordingly, the Examiner is respectfully requested to enter the above amendments, withdraw the rejections, and pass the application to issuance.

Respectfully submitted,

B. J. Boshears
Registration No. 33,864

December 4, 2006
Date

Eastman Chemical Company
P.O. Box 511
Kingsport, Tennessee 37662
Phone: (423) 229-6333
FAX: (423) 229-1239

Docket: 71580 US02

PATENT

CERTIFICATE OF MAILING UNDER 37 CFR 1.8(a)

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

Date: 12-8-06